



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/674,116	09/29/2003	Peter J. Dronzek JR.	181-030B	2428
47888	7590	12/13/2005	EXAMINER	
HEDMAN & COSTIGAN P.C. 1185 AVENUE OF THE AMERICAS NEW YORK, NY 10036			SCHATZ, CHRISTOPHER	
			ART UNIT	PAPER NUMBER
			1733	
DATE MAILED: 12/13/2005				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/674,116

Applicant(s)

DRONZEK, PETER J.

Examiner

Christopher T. Schatz

Art Unit

1733

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 November 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 and 14-23 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-23 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

Applicant's election without traverse of Group I, claims 1-12 and 14-23 in the reply filed on November 2, 2005 is acknowledged.

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 5, 9, and 14-18 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 5 recites the limitation "the reactive catalyst is crosslinkable with either the hydrophilic layer the adhesive layer or both." There is insufficient antecedent basis for this limitation in the claim.

Claim 14 recites the limitation "the print surface." There is insufficient antecedent basis for this limitation in the claim.

Claims 15 and 16 recite the limitation "the printed indicia." There is insufficient antecedent basis for this limitation in these claims.

Art Unit: 1733

Claims 17 and 18 recite the limitations "the exposed polymer layer," and "the moisture activated hydrophilic layer." There is insufficient antecedent basis for these limitations in these claims.

As to claim 9, the phrase "less adhesive is applied than is normally applied to a paper label" is indefinite because the term "normally" is a relative term which renders the claim indefinite. The term "normally" is not defined by the claim, and the specification does not provide a standard for ascertaining the requisite degree. As such, one of ordinary skill in the art could not be expected to understand the scope of the claim.

Double Patenting

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

4. Claims 1-12, and 14-23 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-29 of U.S. Patent No. 6,517,664. Although

Art Unit: 1733

the conflicting claims are not identical, they are not patentably distinct from each other because the claims of the cited U.S. patent disclose all the limitations of the instant application. Although the claims of the reference do not recite the term "microvoided," the definition of a "microvoided polymeric label," according to the specification of the instant application, is one having a density below 0.9 (page 9, lines 12-21). The claims of the reference disclose such a density.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1-12 and 14-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dronzek (WO 99/19412) in view of Amberg '640.

Dronzek is available as prior art under 102(b) because (1) applicant only claims benefit to 10/292231 filed on November 11, 2002, and Dronzek was published more than one year prior to November 11, 2002.

The claims of Dronzek disclose the limitations in claims 1-12 and 14-23 of the instant application. The reference is silent, however, as to a method wherein a microvoided polymeric label is selected. Amberg discloses a method of labeling a container wherein a microvoided

polymeric label is selected (column 5, lines 8-12). The reference further indicates that selecting a polymeric label with microvoids is preferable to the process, and that said polymeric label with said specified microvoids forms a snug, conforming fit around the neck of the container (column 9, lines 9-13). Therefore, at the time of the invention it would have been obvious to a person of ordinary skill in the art to modify the method disclosed by Dronzek by selecting a microvoided polymeric label as taught by Amberg above such that the process of Dronzek produces a label that is adhered in a snug, conforming manner.

7. Claims 1 and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jannusch '884 in view of Amberg '640.

Jannusch is available as prior art under 102(b).

Jannusch discloses a method of a labeling glass, plastic or metal container or surface by means of a water based adhesive composition (column 1, lines 60-65), said method comprising: selecting a polymeric label (column 8, lines 34-38); (b) applying a water based adhesive to said polymeric label form a fastenable polymeric label; fastening said fastenable polymeric label glass, plastic or metal container or surface; and (d) allowing said polymeric label to dry on said glass, plastic or metal surface or container (column 7, lines 19-27). The reference is silent as to a method wherein the selected polymeric label is microvoided.

Amberg discloses a method of labeling a container wherein a microvoided polymeric label is selected (column 5, lines 8-12). The reference further indicates that selecting a polymeric label with microvoids is preferable to the process, and that said polymeric label with said specified microvoids forms a snug, conforming fit around the neck of the container (column 9,

Art Unit: 1733

lines 9-13). Therefore, at the time of the invention it would have been obvious to a person of ordinary skill in the art to modify the method disclosed by Jannusch by selecting a microvoided polymeric label as taught by Amberg above such that the process of Jannusch produces a label that is adhered in a sung, conforming manner.

As to claim 23, the limitations are identical to claim 1 except applicant has replaced the word “dry” with “cure.” Examiner asserts that because of the crosslinking capabilities of the fortifying polymers, the adhesive Jannusch can also be cured.

8. Claims 2-12, 14, and 19-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jannusch and Amberg as applied above, and in further view of Navikas ‘898.

Jannusch and Amberg disclose a method as stated above, and Jannusch further discloses a method wherein an adhesive can further contain hydrophilic fortifying polymers to promote adhesion (column 1, lines 25-31, column 3, lines 36-51). The reference is silent, however, as to a method wherein a hydrophilic layer is applied to a polymeric label before application of a water based adhesive. Navikas discloses a method of adhering a label to a polystyrene surface via a water-based adhesive. The reference further suggests that application of a hydrophilic layer to polystyrene before application of a water based adhesive allows the polystyrene to have better affinity for said water based adhesive. This in turn leads to a better bond between surfaces (column 1, lines 28-50). Examiner acknowledges that Navikas is referring to applying a hydrophilic layer to a polystyrene bottle (not a label). However, applicant should note that polystyrene is the material used for the polymeric label in both Jannusch and Amberg, and because the container of Navikas is the same material as the label of Jannusch and Amberg, the advantages of applying a hydrophilic layer before a water based adhesive is applied disclosed by

Art Unit: 1733

Navikas would pertain to the application of said hydrophilic layer even if said layer is applied to a polystyrene label, rather than a polystyrene container. Therefore, at the time of the invention it would have been obvious to a person of ordinary skill in the art to modify the method disclosed by Jannusch and Amberg such that a hydrophilic layer is applied to the polymeric label before the adhesive as taught by Navikas.

As to claim 3, since the adhesive is water-based, examiner asserts that the application of water to a hydrophilic layer naturally flows from the process disclosed by the combination of the three references. As to claim 4, Jannusch discloses a method wherein the water-based adhesive contains a catalyst (column 3, lines 40-55, column 1, lines 25-30). In light of examiner's reasons presented in the discussion of claim 2 as to why it would have been obvious to apply a hydrophilic layer to a label before the water based adhesive is applied, one of ordinary skill would have readily recognized to apply the water based adhesive containing a catalyst to a hydrophilic layer on a polymeric label. As to claim 5, Jannusch discloses a method wherein the reactive catalyst is crosslinkable with either the hydrophilic layer, the adhesive layer, or both (column 3, lines 36-51). As to claim 6, Navikas discloses a method wherein the hydrophilic layer is a coated, coextruded or extruded layer (column 1, lines 44-46). As to claim 7, Navikas discloses a method wherein the hydrophilic layer is a coated layer (column 1, lines 44-46). As to claim 8, the means for applying the adhesive to the label described on column 7, lines 19-29 of Jannusch – coating using a stirring rod – would indicate to one of ordinary skill in the art that the adhesive is applied with 100% coverage. As to claim 10, Jannusch discloses a method wherein the polymeric label is mono-layer or coextruded film selected from white colored cavitated polypropylene, polyethylene, polyester, polystyrene or polycarbonate (column 8, lines 34-38).

Art Unit: 1733

As to claim 11, Jannusch discloses a method wherein the polymeric label includes a reverse printed clear polymeric film which laminated the microvoided polymeric label surface (column 8, lines 34-42). As to claim 12, Navikas discloses that it is advantageous to use adhesion-promoting compounds to promote the adherence of the hydrophilic layer to the polystyrene (column 1, line 72 – column 2, line 27). While the reference does not explicitly recite a separate adhesion promoting layer, it would have been well within the purview of one of ordinary skill in the art to apply the adhesion promoting compounds as a separate tie layer. As to claim 14, Jannusch discloses a method further comprising an adhesion promoting layer that promotes indicia adhesion because the reference teaches composite labels and further teaches that said composite labels that can support indicia (col. 8, lines 34-42). As to claim 19, Jannusch discloses a method wherein the hydrophilic compound is formulated with humectants (such as urea) for curl control and/or anti-block aids to control the layflat and blocking properties of the label for optimum high speed application (column 3, line 63 – column 4, line 4). As to claim 20, Jannusch discloses a method wherein the aqueous label adhesive is based on starch, casein, synthetic polymer or blends of starch, casein or synthetic polymers (column 3, lines 6-10 and lines 36-39). As to claims 21 and 22, Jannusch discloses a method wherein the hydrophilic layer is a derivative of polyacrylic acid or polyacrylic acid copolymer (column 3, lines 40-50). As to claim 22, examiner asserts that carboxylated sodium polyacrylate is a well known type of acrylate. Absent any unexpected results presented by applicant, the use of carboxylated sodium polyacrylate does not render the limitation patentably distinct over the prior art.

9. Claims 15-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jannusch, Amberg and Navikas as applied above, and in further view of Kelly et al.

Jannusch, Amberg and Navikas disclose a method as stated above, but the references are silent as to a protective coating placed over the printed indicia. Kelly et al. discloses a method wherein a protective coating layer is placed on a substrate that is used as a label wherein said coating layer has slip properties that facilitates use of the coating layer on high speed packaging apparatus (col. 1, lines 16-30). Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to place the protective coating layer of Kelly over the printed indicia disclosed Jannusch such that the method disclosed by Jannusch, Amberg and Navikas is modified to optimize high speed application of said label. Examiner acknowledges that the reference does explicitly recite the phrase “to control the coefficient of friction and static properties.” However, because the reference does disclose that the protective coating has slip aids and/or anti-static aids that facilitate high speed application, said coating controls the coefficient of friction and static properties between the hydrophilic layer and the protective coating.

As to claim 16, Kelly discloses a method wherein a coating with anti-block and/or anti-stick aids is applied to a substrate. As such, one of ordinary skill in the art would have readily recognized that said coating controls the blocking tendency of the moisture activated hydrophilic layer. As to claims 17 and 18, it is unclear to examiner what applicant means by “the exposed polymer layer.” Examiner asserts that because the coating of Kelly controls the coefficient of friction, static properties, and the blocking tendency of the hydrophilic layer when placed over the printed indicia of Jannusch, one of ordinary skill in the art would have readily recognized that the protective coating can perform the same functions (controlling the coefficient of friction,

Art Unit: 1733

static properties, and the blocking tendency of the hydrophilic layer) when placed over an “exposed polymer layer.”


Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Christopher T. Schatz** whose telephone number is 571-272-1456. The examiner can normally be reached on 8:00-5:30, Monday -Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner’s supervisor, Richard Crispino can be reached on 571-272-1226. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

CTS


STEVEN D. MAKI 12-8-05
PRIMARY EXAMINER